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Attorney Docket No. GEMS8081.027

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Singh et al.
Serial No. : 09/710,543
Filed : November 9, 2000
For : A Method of Designing an Electronic Transaction System
Group Art No. : 3627
Examiner : Rudy, A.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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8/3/05

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Jessica A. Calaway

Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The request is being filed with a Notice of Appeal. The review is requested for the reasons set forth hereinafter.

Docketed by: CH
Date: 8-3-05

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REMARKS

Claims 1-10 and 30-48 are pending in the present application. In the Final Office Action mailed June 3, 2005, claims 1-10 and 30-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Barrett et al. (USP 6,029,144). Claims 40-48 have been withdrawn from consideration.

In the rejection of claims 1-10 and 30-39 under 35 U.S.C. § 103(a), the Examiner stated that the claims are unpatentable over Barrett et al. Thereafter, the Examiner took Official Notice of every element of all pending claims, except elements (e) and (f) of claim 1. Apparently, in regard to elements (e) and (f) of claim 1, the Examiner concluded that posting business practices via electronic media on a global communications network would have been obvious to one of ordinary skill in the art. Thus, Barrett et al. is included in the formal rejection of the claims, but never applied in a particularized way to any claims or elements thereof.

In the remarks presented March 9, 2005, Applicant set forth that the Examiner not only did not apply with any degree of specificity how Barrett et al.'s disclosure of "a policy checker 208, e.g. Figs. 3 and 4, that reviews existing and new audit screening processes" is applicable to that which is claimed, but Applicant challenged the Examiner's application of Official Notice. In all, Applicant presented that Barrett et al. is non-analogous and does not teach or suggest the claimed invention. That is, Barrett et al. is directed to "automated employee expense reimbursement auditing." Col. 1, lns. 8-9. Employee expense reimbursement is a cash outflow occurring between an employer and its employees. Col. 5, lns. 1-11; col. 6, lns. 49-57. In contrast, the claimed invention is directed to a system for electronic transactions and sales, which includes cash inflows between a business and its customers. Furthermore, Barrett et al. does not specifically teach a system for electronic transactions. Therefore, Barrett et al. does not appear to be particularly relevant to the claimed invention, and the Examiner apparently did not rely on Barrett et al. for the substance of the rejection of claims 1-10 and 30-39.

To support the rejection of claims 1-10 and 30-39, the Examiner must affirmatively address the following two inquiries that summarize the key issues to be decided on appeal: (1) Has Official Notice been properly taken? (2) Does that which has

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been taken as Official Notice coupled with that taught/suggested by Barrett et al. render the claimed invention unpatentable? As presented previously and reiterated hereinafter, Applicant believes the Examiner cannot affirmatively answer the above inquiries.

Official Notice is a doctrine which may be used to "fill in the gaps" between other documented evidence when the noticed facts are "capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091-92, 165 USPQ 418, 420-21 (CCPA 1970). According to MPEP §2144.03, Official Notice "may provide sufficient support for conclusions only as to peripheral issues." (Emphasis added.) Furthermore, "assertions of ... specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." MPEP §2144.03; *Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21 (stating "we reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice."). In addition, as particularly applied to obviousness rejections, assertions of the "basic knowledge" or "common sense" of one of ordinary skill in the art requires the support of specific factual findings and concrete evidence in the record. Without such, an obviousness rejection based on Official Notice cannot be sustained. MPEP §2144.03; *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

In the instant case, Official Notice constitutes the basis for the vast majority of the rejection, rather than a gap-filler. Official Notice has been applied broadly rather than judiciously; to nearly all limitations of all claims, rather than "peripheral" issues. The Examiner also did not recite any particular facts taken by Official Notice which render the claims obvious. Rather, the Examiner made the conclusory statement that Official Notice is taken of the claim elements themselves.

Specifically, the Examiner stated that the noticed claims and limitations "have been common knowledge in the business world predating Applicant's filing date of the present application." Not only is this conclusory, but it is an assertion of the state of the art at some previous point in time, and cannot be relied upon without documentation and concrete support in the record. MPEP §2144.03. A conclusion that the specific subject

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matter claimed by Applicant is or was known must be supported by "some reference work recognized as standard in the pertinent art." *Id.* However, the present rejection lacks such support. The Examiner has not set forth the required factual findings or concrete evidence.

Applicant believes that the Examiner's failure to include this support is due to the fact that no such evidence or documentation exists to render the claims obvious. Specifically, Applicant believes that at least as of November 9, 2000, the filing date of the present application, it was not common knowledge in the business world to practice Applicant's invention as claimed. Furthermore, there is no showing whatsoever that the allegedly well known elements were all contemporaneously well known before Applicant's filing date. The bare assertion that the noticed subject matter has "been common knowledge in the business world predating Applicants filing date of the present application" does not establish that all the elements of the present claims were known to one of ordinary skill in the art at the same time. The Examiner presented absolutely no basis from which to conclude that the subject matter of every limitation of all claims, except steps (e) and (f) of claim 1, were simultaneously known in the art at some date before the present application was filed.

Thus, there is no support for asserting Official Notice in the instant case. Without a showing of concrete evidence and documentation proving that an individual possessing ordinary skill in the art would have contemporaneously known all Officially Noticed limitations, Official Notice may not be relied upon. MPEP §2144.03. And contrary to the assertions of the Examiner, Applicant has pointed out that the Examiner's use of Official Notice was improper and thus has been adequately traversed. *See Id.* ("to adequately traverse [the use of Official Notice], an applicant must specifically point out the supposed errors in the examiner's action").

Applicant, in the remarks presented March 9, 2005, went to great length to point out the errors in the Examiner's action, as required by MPEP §2144.03. Specifically, Applicant challenged the Examiner's assumption that the allegedly well-known elements were contemporaneously known before Applicant's filing date. That is, the Examiner asserted that every element of claim 1 save steps (e) and (f) were known at the time of

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Applicant's invention. Applicant challenged that assertion. In other words, Applicant has argued that elements (a) – (d) were not common knowledge at the time of Applicant's invention and that the Examiner had failed to offer any evidence that all of elements (a) – (d) were known prior to the effective priority date of the application.

Accordingly, the Examiner's Official Notice statements are not to be considered common knowledge or well-known in the art because at the time of Applicant's invention, the steps called for in elements (a) – (d) were not common knowledge or well-known.

The Examiner has asserted that Applicant's traversal was inadequate. However, the Examiner's reasoning is circular. The Examiner requires proof that elements (a) – (d) were not common knowledge at the time of Applicant's invention. It is not possible to prove a negative. Either the elements were known or not. The Examiner has asserted, without a showing of proof, that they were. Given the rare circumstances in which Official Notice is to be taken, the burden is on the Examiner to substantiate the Official Notice statements. As such, Applicant requests pre-appeal review of the Examiner's Official Notice determination.

In addition, the Examiner's statements asserting the obviousness of steps (e) and (f) of claim 1 are no longer applicable in light of the fact that Applicant believes that Official Notice has been traversed. Step (e) recites "forming electronic media for steps (a) through (d)," and step (f) recites "posting the electronic media on a global communications network." Since the Examiner improperly relied on Official Notice in regard to steps (a) through (d), those steps have not been shown to be obvious. Therefore, steps (e) and (f), as relating back to steps (a) through (d), cannot be said to be obvious. Additionally, Applicant traverses the obvious determination as conclusionary and not based on any valid prior art. Without Official Notice as a basis, the Examiner's comments in regard to steps (e) and (f) are unsubstantiated and do not support a rejection of claim 1.

In sum, the Examiner's use of Official Notice was improper. Additionally, the teachings of Barrett et al. are not analogous and have not been specifically applied to the elements of the pending claims. As such, assuming the Official Notice determination to

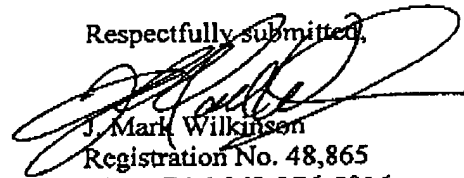
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be proper, the Examiner has not shown that the claimed invention to be obvious. Therefore, in light of at least the foregoing, Applicant requests pre-appeal review of the above issues and, ultimately, allowance of claims 1-10 and 30-39.

Applicant appreciates the consideration of these Remarks and cordially invites the pre-appeal conference committee to call the undersigned, should it consider any matters unresolved.

Respectfully submitted,



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Dated: 8/3/05
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